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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/832,440

Filing Date: April 11, 2001

Appellant(s): MORSA, STEVE

Steve Morsa
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 12/18/2010 appealing from the Office action mailed 7/20/2010.

(1) *Real Party in Interest*

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 181-269 and 271-272

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

PMA ("Peter Martin Releases HelpWorks Web Edition," Business Wire, September 28, 1999).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

1. Claims 182, 204, 226, and 248 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 185, 207, 229, and 251 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. **Claims 271-272 are rejected under 35 U.S.C. 102(a) as being anticipated by PMA ("Peter Martin Releases HelpWorks Web Edition," Business Wire, September 28, 1999).**

3. As per **independent Claims 271 and 272**, PMA discloses a method/apparatus of generating a benefit result list in real or substantially real time (web-based self-service model) in response to a benefit match request from a benefit seeker using a computer network, comprising maintaining at least one database stored in and/or on an article of manufacture including a plurality of benefit listings (eligibility library / Expert Eligibility Server); receiving a benefit match request transmitted from an

article of manufacture from said seeker, said request including said seekers criteria (Criteria Questions answered and inputted into system); identifying using a processing device those of said benefit listings having criteria which generate a match with said match request; generating automatically a message to a receiving article of manufacture to inform said seeker via said computer network of those of said benefits which match said seekers criteria (Users screen themselves).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. **Claims 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, and 254-268 are rejected under 35 U.S.C. 103(a) as being unpatentable over PMA ("Peter Martin Releases HelpWorks Web Edition," Business Wire, September 28, 1999).**
6. As per **independent Claims 181, 203, 225, and 247**, PMA discloses a system [method, computer-readable code, mechanism] comprising: storing in physical memory device benefit information, benefit provider information, and benefit correlation information (Expert Eligibility Server, eligibility library); said processing device analyzing said individuals data, said benefit provider information, and/or said benefit correlation information to determine whether any benefit providers are

offering any benefits applicable to said individual data (Eligibility Screening);
generating a message to at least one receiving device to inform said individual, at least in part via a computer compatible network, of any benefits applicable to said individuals data (Web enabled self-service module).

7. PMA fails to expressly disclose inputting at least a sub-set of an individual demographic, geographic, and/or psychographic data into a processing device by means of at least one data entry device in electronic communication with the processing device.
8. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include a multitude of available input criteria to match with the benefit programs in the eligibility library, for the purpose of increasing the system's accuracy in matching results (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.")).
9. As per Claims 184, 206, 228, and 250, PMA discloses storage of at least a portion of said individual's data (inherent to internet operations – Expert Eligibility Server) (Claims are dependent on a previously independent claim rejected under 103 (a)).

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10. As per Claims 188, 210, 232, and 254, PMA fails to expressly disclose requiring said individual to update said individuals data as a condition of said individual continuing to remain a system user.
11. However, Official Notice is taken, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to require up-to-date information from a user, in order to provide valid results; and a real-time system would obviously require continual maintenance from users to ensure up-to-date data.
12. As per Claims 189, 211, 233, and 255, PMA fails to expressly disclose said individual and or at least one of said benefit providers to pay for said system access and use from at least one from the group of: on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said individuals relinquishment of at least a portion of at least one of said benefits; through the cash or cash equivalent payment of some part or percentage of the value of at least one of said benefits.
13. However, the article describing the HelpWorks system, does suggest that the system is to be provided by Peter Martin Associates to the public, and Official Notice is taken that charging for services provided to users was a well-known form of business at the time the invention was made. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to charge for the services provided by PMA.

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14. As per Claims 190, 212, 234, and 256, PMA discloses receiving directly and or via one or more third party intermediaries of monetary revenue and or other value from at least one benefit provider (PMA Commerce – See rejection of Claims 189, 211, 233, and 255).
15. As per Claims 191, 213, 235, and 257, PMA discloses one or more from the group of: updating benefits data; modifying benefits data; removing benefits data; adding new benefits data (user configurable).
16. As per Claims 192, 214, 236, and 258, PMA discloses said message to: reveal one or more of said benefits not applicable to individual; provide one or more of said benefit providers not applicable; provide one or more of said benefit providers benefit application forms; provide one or more of said benefit providers contact information; provide a map for and or direction to one or more of said benefit providers (HelpWorks system is meant to be a screening an *referral* tool).
17. As per Claims 193, 215, 237, and 259, PMA discloses at least one from the group of: *connecting said individual with at least one of said plurality of benefit providers*; said individual to interact with at least one of said benefits to said individual; completion of one or more application forms, when applicable, by said individual; assisting transmitting at least one benefit approval for said individual by at least one of said benefit providers; transmitting an acceptance of at least one of said benefits by said individual; receiving at least one of said benefits by said individual; utilizing at least one of said benefits by said individual (HelpWorks system is meant to be a screening an *referral* tool).

18. As per Claims 194, 216, 238, and 260, PMA discloses performing at least one of the listed means for in real or near real time (Web-based system).
19. As per Claims 195, 217, 239, and 261, PMA discloses wherein said individual benefits or benefits information is shared with at least one other entity via said system (Provide user results in caseworker example).
20. As per Claims 196, 218, 240, and 262, PMA discloses wherein said message includes at least one benefit for which said individual: *may qualify for*; and or may not qualify for; and or does qualify for; and or does not qualify for (Pg.1).
21. As per Claims 197, 219, 241, and 263, PMA fails to expressly disclose discloses wherein said message informs individual of at least one benefit contained within said memory without regards to at least some part of said individual's data.
22. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include benefits that matched all entered criteria as a general baseline or to offer basic results to all users.
23. As per Claims 198, 220, 242, and 264, PMA discloses wherein one or more of said benefit providers submit said benefit information and or said benefits directly into said system (User configurable).
24. As per Claims 199, 221, 243, and 265, PMA discloses wherein at least one of said benefit information and or said benefits from at least one of said benefit providers is delivered directly into said system via at least one third party

intermediary acting on behalf of at least one of said benefit providers (PMA configured presets – government benefits).

25. As per Claims 200, 222, 244, and 266, PMA fails to expressly disclose wherein said available benefits vary according to: the amount of said individual's data; and or the completeness of said individual's data.
26. However, PMA does disclose an eligibility-screening tool based on entered criteria, and the amount of criteria entered would obviously equate to varying amounts of system matches (well known function of database correlation systems).
27. As per Claims 201, 223, 245, and 267, PMA fails to expressly disclose wherein at least a partial set of phantom individual's data is inputted; wherein said phantom data does not belong to nor correspond to said individuals actual factual data.
28. However, the phantom data, as claimed above, is simply a user decision to experiment with data inputs to investigate available options, and it would have been obvious to users at the time the invention was made to complete trial and error techniques with the system to investigate the best-fit options available to them.
29. As per Claims 202, 224, 246, and 268, PMA fails to expressly disclose wherein said individuals data includes said individuals identification information.
30. However, PMA does disclose wherein the system can be used as a self-service model; therefore, the user would have to include some sort of identification (e-mail, web-connection ID) in order to receive results from the system.
31. Furthermore, PMA discloses wherein the system is used by caseworkers, who would obviously require a user ID to identify/separate specific case evaluations.

Allowable Subject Matter

32. **Claim 269 is allowed**

33. As per Claim 269, the prior art fails to expressly teach or disclose wherein said requester thereafter receives, utilizing said stored request and via a data receiving device, at least one automatically generated updated subset of said benefit information.

34. **Claims 182, 185, 204, 207, 226, 229, 248, and 251 are considered allowable** if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35. As per Claims 182, 204, 226, and 248, the prior art fails to expressly teach or suggest means for the display of said benefits to said individual in a manner selected from the group consisting of benefit class or category; value of benefits; cost, if any, of benefits; importance of benefits; relevance of benefits; ease of use of benefits; expiration date, day, time of benefits; creation date, day, time of benefits; types of benefits; physical proximity of said individual to one or more of said benefit providers.

36. Claims 183, 205, 227, and 249 are considered allowable as they depend directly on allowable claims.

37. As per Claims 185, 207, 229, and 251, the prior art fails to expressly teach or suggest means for updating the status and or availability of benefits for said individual as: at least one of said benefit providers intends to or actually does modify

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the existing benefit qualification parameters for one or more of said providers benefits; and or at least one of said benefit providers intends to or actually does modify or eliminate an existing benefit, or offers one or more benefits not previously offered; and or one or more individual applicable benefits offered by one or more benefit providers new to, or returning to, said system are added to said system.

38. Claims 186, 208, 230, and 252, are considered allowable as they depend directly on allowable claims.

39. Claims 187, 209, 231, and 253 are considered allowable as they depend directly on allowable claims.

(10) *Response to Arguments*

40. The Appellant has made the argument that the cited prior art of PMA (9/28/99, press release), is not valid prior art because an additional press release was issued regarding similar subject matter on 4/24/2001. However, the Examiner believes the press release issued on 9/28/99 is valid and is similar but different from the press release issued on 4/24/2001. The arguments made by the Appellant regarding the validity of the cited prior art hold no proof that the original press release (9/28/99) was improper and are merely speculative comments. The Examiner also believes that the original press release (9/28/99) contained sufficient subject matter, which would enable one of ordinary skill in the art at the time the invention was made to recreate the business method/system.

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41. As per independent claims 271 and 272, the Appellant has made argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which applicant relies (i.e., more than human benefit-matching, multiple types of benefits, multiple supported agencies, privacy discloser) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
42. As per independent claims 181, 203, 225, and 247 the Appellant has made the argument that the cited prior art only covers a small portion of the claimed subject matter.
43. However, PMA teaches the subject matter as broadly claimed by the applicant. For example independent claim 181 discloses matching benefits from benefit providers to individuals eligible to receive benefits, which is clearly covered by the cited prior art of PMA.
44. PMA discloses a method/system for offering benefits from a wide variety of benefit providers to a wide variety of "consumers." The Examiner believes that the language used by the prior art for method/system users is equivalent to the stated users indicated by the Appellant.
45. Finally the Appellant has made the argument that the cited prior art fails to teach several elements taught by the dependent claims.
46. However, the last Non-Final office action was issued (7/20/2010) to incorporate a 103(a) rejection in order to explain the obviousness of the claimed subject matter

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contained in the dependent claims in comparison to the cited prior art of PMA and Official Notice. Therefore, the Appellant and BPAI are directed to the rejection above for answers to arguments.

47. The Appellant has made several arguments (unexpected results, synergism, multiplicity of steps, objective evidence, commercial success, solution of long-felt need, and competitive recognition) indicating that the independent claims are unobvious and patentable over the cited references.

48. However, as stated in Chapter 700 of the MPEP:

**I. >< TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE
SHOULD BE SUPPORTED BY ACTUAL PROOF**

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

**II. >< ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF
EVIDENCE**

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See MPEP § 2145 generally for case law pertinent to the consideration of applicant's rebuttal arguments.

**I. >< BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE
UNEXPECTED AND SIGNIFICANT**

The evidence relied *>upon< should establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); *Ex parte C*, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

716.03(a) [R-2] Commercial Success Commensurate in Scope With Claimed Invention

I. >< EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate *in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

3. The Appellant has also made several arguments (assumed insolubility, new principle of operation, references teach away, different problem solved, lack of implementation) indicating that the independent claims are unobvious and patentable over the cited references.
4. However, the above rejection discloses cited prior art which teaches the claimed invention (independent claims 1, 80, 164, 169, and 176), and was implemented through a website.

(11) Related Proceeding(s) Appendix

The BPAI issued a decision on this Application previously on 2/26/2010

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

February 1, 2011

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